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PATENT APPLICATION
Attorney Docket No. Q48591

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Jiangtao WEN, et al.

Appln. No.: 09/203,672

Group Art Unit: 2613

Confirmation No.: 4494

Examiner: Shawn An

Filed: December 1, 1998

For: METHOD FOR REPRESENTING ENCODING UPON
CODING VIDEO INFORMATION

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REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

Commissioner for Patents
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellants respectfully submits this Reply Brief to address points raised by the Examiner's Answer of December 28, 2001. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

In the Appeal Brief, it was generally argued that Suzuki et al does not teach generating an extended code (COD) field representing a coding state of information which is transmitted and including, in the extended code field, a bit stream indicating whether both a motion vector (MV) and a discrete cosine transform (DCT) value are not encoded, whether both the MV and the DCT are encoded, and whether only the MV is encoded.

More specifically, it was argued that Suzuki et al discloses generating a COD field representing a coding state of the information, and discloses, at col. 33, lines 54-60, including, in the COD, a bit stream indicating whether both a motion vector and a DCT value are not encoded, but does not disclose that the COD indicates whether both the motion vector and the DCT are encoded (at col. 35, lines 1-8 as indicated by the Examiner, or anywhere else in the patent), or whether only the motion vector is encoded (at col. 34, lines 31-40 and col. 35, lines 1-3 as indicated by the Examiner, or anywhere else in the patent).

With respect to Appellant's argument that Suzuki et al does not disclose that the COD indicates whether both the motion vector and the DCT are encoded, the Examiner states: "Suzuki clearly teaches that if ac components other than 0 are present in the DCT coefficients of the I or P picture, the COD flag becomes 0, and the subsequent data may be transmitted (col. 33, lines 63-66). In other words, both a motion vector MV and a discrete cosine transform (DCT) are encoded." (Examiner's Answer, page 4, first full paragraph; emphasis in original.)

Appellant submits, however, that the portion of Suzuki et al cited by the Examiner teaches that setting the COD to "0" merely indicates the presence of non-zero DCT coefficients. There is no suggestion that setting the COD to "0" indicates the presence of a motion vector.

With respect to Appellant's argument that Suzuki et al does not disclose that the COD indicates whether only the motion vector is encoded, the Examiner states:

[I]t is indeed true that Suzuki's COD field contains only one bit. However, the Suzuki incorporates both the COD (Fig. 40A) and the MODB field codes (Fig. 40B) as extended code fields to meet the Appellant's extended field codes (COD) having

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at least two bits. Suzuki also discloses having the extended field code 00 indicating neither the MV nor the DCT values are encoded, a bit value 11 indicating both the MV and DCT value are encoded, and a bit value 10 indicating only the MV is encoded (col. 35, lines 3-8). Therefore, it's quite clear that not only Suzuki teaches Appellant's extended field code (COD), but also discloses the same concept of the extended field code having two bits in the form of MODB field. In other words, Suzuki's reference teaches Appellant's extended field codes and its concepts (methods). Appellant incorporates the extended field code (COD) having two bits, while Suzuki's reference have the substantially same extended field code (COD) having one bit in combination with MODB field codes as having two bits, but the results are identical.

(Examiner's Answer, page 4, second full paragraph.)

Appellant respectfully submits that the Examiner has improperly extended the concept of a two bit MODB field to the COD field. As will be explained below, Suzuki does not "have the substantially same extended field code (COD) having one bit in combination with MODB field codes as having two bits", and the results are not identical.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

See MPEP § 2131. Appellant specifically claims features relating **to the COD field**. As argued in Appellant's Appeal Brief, the terms "COD" and "MODB" have art recognized meanings. Suzuki clearly distinguishes between "COD" and "MODB"; Suzuki uses COD in the context of Fig. 40A, that is, in the context of an I- or P-picture (VOP) (col. 33, lines 51-52) and the COD is clearly a one bit indicator. Suzuki uses the term MODB in the context of Fig 40B, that is, in the context of a macro-block of a B-picture (VOP) (col. 34, lines 25-26). The Examiner admits that Suzuki's COD contains only one bit field. ("[I]t is indeed true that Suzuki's COD field contains only one bit." (Examiner's Answer, page 4, first sentence of first full paragraph.)) Therefore, Suzuki explicitly teaches a one bit COD field which is not capable of performing the indications specifically claimed for the COD field of claim 8.

Nonetheless, the Examiner extends attributes of Suzuki's MODB field to Suzuki's COD field. Appellant submits that the Examiner's attempt to attribute characteristics of Suzuki's MODB field to Suzuki's COD field is improper, since these are art recognized different concepts. Simply put, Suzuki teaches a **one bit COD field** which is incapable of operating in the manner claimed in claim 8. Suzuki does not teach a COD field capable of operating as claimed.

With respect to the Examiner's reasoning that extending a COD to two bits has an identical result to that of a two bit MODB, Appellant respectfully disagrees. As taught by Suzuki, a two bit MODB specifies certain characteristics of a macro-block of a B-picture (col. 34, lines 25-30), and a one-bit COD specifies certain characteristics of a macro-block of an I-picture or P-picture (col. 33, lines 51-52). Therefore, Suzuki teaches no mechanism for using

more than one bit to specify the claimed characteristics of a macro-block of an I- or P-picture.

At least for this reason, the results are not identical.

The Examiner also states:

Moreover, the Examiner believes generating an extended code field has far more patentable weight than simply calling it a (COD). The Examiner further believes that an abbreviated term such as COD, MODB, or any other suitable terms in parenthesis, could easily be changed into some other term as a standard term or as a non-standard as appropriate. Therefore, as long as the extended code field representing its coding state of the information, and its limitations are met, the abbreviated terms associated with the extended code field should be considered Appellant's equivalent terms.

(Examiner's Answer; Page 5.)

Appellant submits that this reasoning is incorrect for several reasons. With regard to the statements, "[T]he Examiner believes generating an extended code field has far more patentable weight than simply calling it a (COD). The Examiner further believes that an abbreviated term such as COD, MODB, or any other suitable terms in parenthesis, could easily be changed into some other term as a standard term or as a non-standard as appropriate", Appellant submits that this reasoning is not appropriate in an anticipation rejection. First, Appellant does not "simply call" a certain field a "COD". This is a term having a specific meaning in the art. The Examiner is referred, for example, to Standard H.263 of the International Telecommunication Union, where the terms COD and MODB are used to relate to separate concepts which are clearly different from each other. It is additionally noted that the reference cited by the Examiner uses

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the terms COD and MODB to relate to concepts which are clearly different from each other. Therefore, in rejecting claim 8, which recites a “COD”, which is a term having an art recognized meaning, it is improper for the Examiner to ignore the art recognized meaning in an anticipation rejection. What the Examiner must consider is whether or not the reference teaches, either explicitly or inherently, a COD, as that term is used in the art, with the claimed attributes. That an Examiner believes that a reference teaches something close to what is claimed is insufficient to support a rejection under 35 U.S.C. § 102. That the Examiner “believes that an abbreviated term such as COD, MODB, or any other suitable terms in parenthesis, could easily be changed into some other term as a standard term or as a non-standard as appropriate” is also irrelevant in an anticipation rejection. The concept of “could easily be changed” can find no place in an anticipation rejection, where a single reference must teach all of the claimed features. The law is well settled; if the teaching of the reference needs to be “changed” to fit the claim, an anticipation rejection is not appropriate.

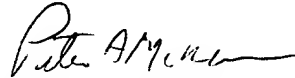
The reasoning underlying the rejection is based either on reading out of claim 8 the term “COD” or “changing” the teaching of the reference to fit the claim so that concepts at variance with the art recognized term “COD” are introduced into the term. In either event, Appellant believes that this reasoning is improper and should not be sustained.

Rather than repeating the arguments presented in the Appeal Brief, reference is made to those arguments, particularly the arguments relating to claim 11.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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